

Applicant : Simon M. Furnish
Serial No. : 10/037,306
Filed : December 31, 2001
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Attorney's Docket No.: 12253-032001 / InfraReDx-14

REMARKS

Section 102 rejection

Applicant had assumed, on the basis of the references to reflective surfaces 38, 103 in the first Office Action, that the Office considered the embodiments of FIGS. 4 and 12A to be those that taught the claimed invention. In light of the Office's clarification, Applicant now understands that it is in fact FIGS. 19, 22, and 23 that are considered to disclose the claimed invention.

Applicant agrees that the embodiment shown in FIGS. 19, 22, and 23 does indeed show first and second fibers 30. However, those figures fail to teach

"an elongated housing supporting a first reflective surface *and* a second reflective surface being longitudinally spaced apart from one another"

The only reflective surface disclosed in the embodiment of FIGS. 19, 22, and 23 is a mirror 146. Since only one mirror is disclosed, there cannot possibly be a disclosure of two reflective surfaces "longitudinally spaced apart from one another" as required by claim 1.

Claim 1 also requires

"a first flexible, elongated energy bearing delivery fiber having a distalmost end arranged adjacent to said first reflective surface."

The distal ends of the optical fibers 30 shown are not adjacent to the disclosed mirror 146 as required by the claim. The disclosed mirror 146 is in fact adjacent to the ultrasound transducer 142. This makes sense in view of its function, which is to intercept and reflect the ultrasonic signal 142a.¹

In *Winston*, outer ends 30b of the fibers 30 are adjacent to a shutter 134. Inner ends 30a of the fibers 30 are adjacent to what appears to be a transparent window. The fibers 30 do not

¹ *Winston*, col. 10, lines 31-32 ("The ultrasonic signal 142a emitted by transducer 142 is intercepted by an included mirror 146 and reflected by the mirror in a forward direction").

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appear to have "a distalmost end arranged adjacent to said first reflective surface" as required by the claim.

Applicant concedes that *Winston* discloses the existence of parts that, if assembled according to Applicant's specification, could be used to construct a device along the lines recited in the claims. For example, *Winston* teaches that there exist optical fibers, and that sometimes two or more such fibers can be in a catheter. *Winston* also teaches that there exist reflective surfaces, and that such reflective surfaces can in some cases be placed in association with a catheter.

The Office's approach thus appears to be to pick and choose parts from various embodiments disclosed in *Winston* and to then assemble them into the claimed invention. This is not proper. The relevant statute, 35 USC 102(b), states in pertinent part that:

"A person shall be entitled to a patent unless...(b) *the invention* was...described in a printed publication..."

The statute does *not* say

"A person shall be entitled to a patent unless...(b) *the constituent parts* of the invention were...described in a printed publication..."

At best, *Winston* describes certain constituent parts of the invention. These parts are scattered among numerous embodiments of a catheter assembly. Each embodiment shows some but not all of the constituent parts recited in claim 1. However, no single embodiment shows all the elements listed in claim 1 assembled with precisely the limitations recited in claim 1. In short, *Winston* does not show *the invention itself*, either as recited in claim 1, or as recited in any of the claims. Accordingly, the statutory requirement that *the invention* be described is plainly not met.

In view of the foregoing, Applicant requests reconsideration and withdrawal of the section 102 rejection of the claims.

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Now pending in this application are claims 1-38, of which claims 1, 20, and 33 are independent. Of these, claims 9-12, 26-29, and 38 are considered to recite allowable subject matter.

No additional fees are believed to be due in connection with the filing of this request for reconsideration. However, to the extent fees are due, or if a refund is forthcoming, please adjust our deposit account 06-1050, referencing attorney docket number "12258-032001."

Respectfully submitted,

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